REMARKS

Applicants and the undersigned thank Examiner Stephenson for his careful review of this application. Reconsideration of the present application is respectfully requested in light of the following remarks.

Claims 1-73 were previously pending in this application.

Claims 1-48 were withdrawn by the Examiner.

Claims 49-57 and 61-70 have been rejected.

Claims 58-60 and 71-73 have been allowed.

REJECTIONS UNDER 35 U.S.C. § 103

Applicants respectfully traverse the rejection of claims 49-57, 61-65, 67, 68 and 70 under 35 U.S.C. 103(a) as being unpatentable over Campbell (US 5,924,745) in view of Schummer et al. (US 4,605,449) for the following reasons.

Claims 49, 50 and 51

To support a *prima facie* case of obviousness, the Examiner must show that the combination of Campbell and Schummer teach or suggest every element of the claims. In claim 49, the expandable member is formed from "a steel alloy comprising a charpy energy of at least about 90 ft-lbs." The Examiner states that Campbell discloses an expandable tubular made from a steel alloy. The Examiner combines this with Schummer's teaching that a steel reinforcing rod was "tested at 35 J for the Charpy V impact test," and concludes that "it is believed that at the range of temperatures used during the test the steel achieved a Charpy energy of 90 ft-lbs." First, Campbell does not teach that the expandable tubular is made from steel alloy; this cannot be found in the text. Because Schummer's disclosure is limited to a solid, unexpandable rod, the cited combination fails to teach an expandable member formed from a steel alloy. Second, Schummer simply does not disclose the claimed feature of a steel alloy comprising a charpy energy of at least about 90 ft-lbs. The Examiner's "belief" that Schummer discloses the claimed feature is not enough to support a *prima facie* case of obviousness, wherein the cited combination must disclose or suggest every element of the claim. If the Examiner's belief is supported by evidence, Applicants respectfully request the Examiner cite prior art which supports the Examiner's position.

For at least these two reasons, the claimed combination does not teach or suggest every element of claim 49.

Further, the Examiner's reasoned statement would not lead one having ordinary skill in the art to make the proposed combination. The skill artisan, viewing Campbell (which does not disclose a steel expandable member), would not look to Schummer because Schummer does not teach an expandable member and, therefore, it is unclear what benefits Schummer would provide an expandable member.

For at least these reasons, claim 49 is allowable over the cited art. For at least these same reasons, claims 50 and 51 are also allowable over the cited art because they include similar features.

Claims 52, 53, 54, 67 and 70

In claim 52, the expandable member is formed from "a steel alloy comprising a weight percentage of carbon of less than about 0.08%." First, as stated above, Campbell does not teach that the expandable tubular is made from steel alloy. Likewise, it is unclear why and how the skilled artisan would look to the steel, cement-reinforcing rod of Schummer (which is not intended for expansion) to arrive at the claimed expandable member formed from a steel alloy comprising a weight percentage of carbon of less than about 0.08%. While resiliency is a good characteristic for a downhole tubular, it does not explain why the skilled artisan, having the expandable tubular of Campbell, would turn to Schummer's rod materials that are in no way related to expansion. In fact, the "reinforcing" nature of Schummer's rod would most likely lead a skilled artisan away from Schummer when looking for materials for plastic deformation.

For at least these reasons, claim 52 is allowable over the cited art. For at least these same reasons, claims 53 and 54 are also allowable over the cited art because they include similar features.

Applicants also believe claims 67 and 70 to be allowable for similar reasons.

Claims 55, 56 and 57

In claim 55, the expandable member is formed from "a steel alloy comprising a weight percentage of carbon less than about 0.20% and a charpy V-notch impact toughness of at least about 6 joules." Again, Applicants repeat the assertion that Campbell does not teach that the expandable tubular is made from steel alloy, and because a reasoned link to Schummer cannot be

made, the cited combination fails to teach an expandable member formed from a steel alloy. To the best of Applicants' interpretation, the Examiner's other contention is that Schummer discloses that the steel reinforcing rod was "tested at 35 J for the Charpy V impact test," and that "it is believed that at the range of temperatures used during the test the steel achieved...an impact toughness of at least 6 joules." Schummer, even if properly combined with Campbell, simply does not disclose the claimed impact toughness. The Examiner's "belief" that Schummer discloses the claimed feature is not enough to support a *prima facie* case of obviousness, wherein the cited combination must disclose or suggest every element of the claim. If the Examiner's belief is supported by evidence, Applicants respectfully request the Examiner cite prior art which supports the Examiner's position. For at least these reasons, the claimed combination does not teach or suggest every element of claim 55.

For at least these reasons, claim 55 is allowable over the cited art. For at least these same reasons, claims 56 and 57 are also allowable over the cited art because they include similar features.

Claims 61, 62 and 63

In claim 61, the expandable member is formed "with a ratio of an outside diameter of the expandable tubular member to a wall thickness of the expandable tubular member ranging from about 12 to 22." Without repeating the deficiencies in Campbell and its combination with Schummer already discussed, Applicants note that Campbell does not teach the claimed feature. The feature cannot be found in the text of Campbell, and to the extent the Examiner relies on the drawings, the drawings are not to scale and cannot be relied upon to teach specific dimensions. If the Examiner believes the claimed feature to be supported by evidence, Applicants respectfully request the Examiner cite prior art which supports the Examiner's position. For at least these reasons, the claimed combination does not teach or suggest every element of claim 61.

For at least these reasons, claim 61 is allowable over the cited art. For at least these same reasons, claims 62 and 63 are also allowable over the cited art because they include similar features.

Claims 64 and 65

In claim 64, the expanded member includes an outer portion of the wall thickness having tensile residual stresses. Without repeating the deficiencies in Campbell and its combination with

Schummer already discussed, Applicants note that Campbell does not teach the claimed feature. The feature cannot be found in the text of Campbell. If the Examiner believes the claimed feature to be supported by evidence, Applicants respectfully request the Examiner cite prior art which supports the Examiner's position. For at least these reasons, the claimed combination does not teach or suggest every element of claim 64.

For at least these reasons, claim 64 is allowable over the cited art. For at least these same reasons, claim 65 is also allowable over the cited art because it includes similar features.

Claims 66 and 69

Applicants respectfully traverse the rejection of claims 66 and 69 under 35 U.S.C. 103(a) as being unpatentable over Campbell in view of Schummer et al. and Gil et al. (US 4,710,347) for the following reasons.

In claim 66, the expandable member is strain aged and then radially expanded and plastically deformed. First, Applicants are unclear where the Examiner finds support for strain aging the expandable member. If the Examiner believes the claimed feature to be supported by evidence, Applicants respectfully request the Examiner cite prior art which supports the Examiner's position. Further, Gil, like Schummer, is not a source a skilled artisan would look to when considering the expandable member of Campbell, or vice-versa, as discussed at length herein. Applicants also repeat the other deficiencies in Campbell and Schummer as shown herein. For at least these reasons, the claimed combination does not teach or suggest every element of claim 66.

For at least these reasons, claim 66 is allowable over the cited art. For at least these same reasons, claim 69 is also allowable over the cited art because it includes similar features.

CONCLUSION

The foregoing is submitted as a full and complete Response to the Non-Final Office Action mailed December 12, 2007. Applicants have made a diligent effort to advance the prosecution of the application by submitting arguments in support of the patentability of the pending claims. In view of the above, reconsideration of the rejections and allowance of the pending claims is respectfully requested.

As the three-month statutory period for reply expired on March 12, 2008, this Response includes a petition for a one-month extension of time. Should the Commissioner deem any other

fees as being due, including any fees for any extensions of time, the Commissioner is hereby authorized to debit said fees from, or to credit any overpayments to, USPTO Deposit Account Number 50-3786, Reference No. 2725-12903.

The Examiner is invited to contact the undersigned via telephone at the number listed below if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

/Matt Moscicki/

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